

Remarks

The present Amendment is submitted in response to the final Office Action dated February 3, 2009. Reconsideration and allowance of the application in view of the following remarks is respectfully requested.

In the final Office Action, claim 16 is rejected under 35 USC §112, second paragraph as indefinite. In response, applicants have amended claim 16 as shown above in the Listing of Claims. Support for claim 16 is found in applicants' disclosure in Fig. 1, and at page 4, line 32, through page 5, line 5. Applicants, therefore, respectfully request withdrawal of the rejection of claim 16 under 35 USC §112, second paragraph.

The final Office Action also rejects claims 1-3, 9, 11-21 under 35 USC §102(b) as anticipated by US Patent No. 5,919,085 to Izumisawa (Izumisawa), and claims 4, 5 and 22 under 35 USC §103(a) over Izumisawa.

In response, applicants have amended independent claim 9 as shown above in the Listing of Claims, and respectfully assert that independent claim 1 and amended independent claim 9 are distinguishable from Izumisawa under sections 102 and 103 for at least the following reasons.

That is, applicants' claim 1 sets forth a hand-held power tool comprising a housing (10) and a motor (12). The motor (12) is located in the housing (10) and drives a shaft (16) that extends from a face end (14) of the housing (10). The housing (10) further comprises a suction conduit (18), extending at least partway

through the housing (10) that operates as an intake at a face end (14) of the housing.

Applicants' claim 9 calls out a system comprising a hand-held power tool, in particular a sander, comprising a housing (10) and a motor (12), which is located in the housing (10) and by which a driven shaft (16), extending from a face end (14) of the housing (10), is drivable, and further comprising a first suction conduit (18), extending at least partway through the housing (10), the system further comprising a tool receptacle with a second suction conduit (20), wherein the first suction conduit (18) in the housing (10) of the hand-held power tool and the second suction conduit (20) in the tool receptacle are intended for direct coupling such that in an installed state of the tool receptacle are coupled via a region (26) that is open in a radial direction towards the outside of the hand-held power tool and the tool receptacle.

Izumisawa does not include each of the elements of applicants' claims 1 and 9. That is, Izumisawa discloses an abrading tool with an upper housing 1 having a drive means (motor) for driving a spindle 25. Spindle 25 extends through upper housing 1, into and through a lower housing 35. At one end of lower housing 35, a hose 43 is connected to an exhaust duct 42, the exhaust duct 42 extending from a chamber 41 (Fig. 1, col. 2, lines 55-59; col. 4, lines 25-32; 42-60).

While the Examiner asserts with respect to claim 1 that Izumisawa discloses a sander comprising a housing 1, 35, a motor for driving a shaft 25 and

that housing 1, 35 has a suction conduit 42 (as claimed) that extends along an underside of motor 11, 12, 13, past a bearing flange 38 to an outlet stub, applicants respectfully disagree.

Izumisawa's upper housing 1 includes the motor 11, 12, 13 and shaft 25, and lower housing 35 includes conduit (exhaust duct) 42. Izumisawa's lower housing 35 surrounds a portion of shaft 25, but does not surround any region of the motor. Hence, Izumisawa's does not include a housing which houses a motor and a spindle 25 extending out of the housing to drive abrading pad 28.

Moreover, neither Izumisawa's upper housing 1 or lower housing 35 can be said to include a suction conduit extending at least partway through the housing and *operating as an intake at a face end of the housing*, as claimed (emphasis added). That is, while the Examiner asserts that Izumisawa's exhaust duct (suction conduit) 42 extends along under side of motor 11, 12, 13, this is not the case.

Izumisawa's lower housing 35 comprises chamber 41 including an exhaust duct 42 formed at the rear of the abrading tool. Exhaust duct 42 is in communication with outlet duct 16 and connected to hose 43. Air received through intake duct 9 leaving cylinder 12 of the motor passes through outlet duct 16 through opening 46 and into exhaust duct 42 and out through hose 43.

Izumisawa's exhaust duct 42, therefore, is not a suction conduit located under motor 11, 12, 13. Nor is exhaust duct 42 located in the front end of either upper housing 1 or lower housing 35, or act as an intake. Hence, Izumisawa's

exhaust duct 42 cannot be a suction conduit extending at least partway through a housing operating as an intake at a face end 14 of the housing, as claimed.

And while the Examiner asserts with respect to claim 9 that Izumisawa further discloses a tool receptacle 28 with a suction opening 30 coupled to conduit 42 open towards the outside of tool 47 to form an annular gap, applicants again disagree.

Izumisawa's abrading pad 28 with holes 30 is not equivalent to applicants' tool receptacle with second suction conduit (20). Holes in the abrading pad are not a second suction conduit coupled to the first suction conduit, as claimed. Particulates and dust may be drawn into chamber 41 from the periphery of abrading pad 28 through space 47, through aperture 45. Hence, annular space 47 is not "outside of the hand-held power tool" and communicates directly with chamber 41, not exhaust duct 42.

In view of the fact that independent claims 1 and 9 recite these limitations, which Izumisawa does not, Izumisawa does not anticipate the inventions of claims 1 and 9.

Applicants further respectfully assert that Izumisawa is not a proper reference under 35 USC §102 pursuant to the guidelines set forth in the last paragraph of MPEP §2131, where it is stated that "a claim is anticipated only if each and every element as set forth in the claims is not found, either expressly or inherently described, in a single prior art reference," and that "the identical invention must be shown in as complete detail as is contained in the ... claim."

Independent claims 1 and 9 are therefore patentable under 35 USC §102(b) over Izumisawa. Claims 2, 3 and 11-19, which depend from claim 1, and claims 20 and 21, which depend from claim 9, are patentable under section 102(b) over Izumisawa for at least the same reasons.

Moreover, because claims 4 and 5 depend from claim 1, and claim 22 depends from claim 9, these claims are also patentable under section 103(a) over Izumisawa for at least the reasons set forth for the patentability of claims 1 and 9. Applicants, therefore, respectfully request withdrawal of the rejection of claims 1-5 and 9 and 11-122 over Izumisawa and the allowance of each of these claims.

Accordingly, the application as amended is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application in condition for allowance.

Respectfully submitted,

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